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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,127	05/31/2001	Jeffrey D. Anderson	ITWO:0006	2561

7590 04/08/2004
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EXAMINER

SCHIFFMAN, JORI

ART UNIT PAPER NUMBER

3679

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,127

Applicant(s)

ANDERSON ET AL.

Examiner

Jori R. Schiffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,11-14,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11-14,26 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03192004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 4, 6-9, and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Bydalek (US6435791).

Regarding claim 1, in Fig. 5 Bydalek discloses an internally threaded fastener assembly comprising a stemmed washer having a washer portion 32 with an abutment surface capable of abutting a surface of a material, a standoff portion 36 integral with the washer portion and configured to extend substantially through material of a defined thickness and capable of substantially limiting compressive loading on the material, a retaining portion 54 integral with the washer portion, and an internally threaded fastener 18 disposed adjacent to the washer portion and retained rotatably in assembly with the stemmed washer by the retaining portion.

Regarding claim 2, Bydalek discloses a peripheral flange 22 on the fastener, and the retaining portion extends radially inwardly to capture the flange and retain the fastener in the assembly.

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As to claim 4, Bydalek discloses the standoff portion 36 forms a hollow right cylinder.

Regarding claim 6, Bydalek discloses the fastener is a threaded nut having flats extending from the stemmed washer.

In regards to claim 7, in Fig. 5 Bydalek discloses an internally threaded fastener assembly comprising a threaded nut 18 having a lower peripheral flange 22, a base 16 having a washer portion 32 having a material abutment surface (the flat portion under 32), a standoff portion 36 extending from the washer portion, and a retaining skirt portion 54 extending integrally from the washer portion and capturing the peripheral flange of the nut to retain the nut rotatably in assembly with the base, wherein the standoff portion is capable of limiting displacement of a threaded fastener securable to the threaded nut relative to the washer portion.

As to claim 8, Bydalek discloses the fastener is a threaded nut having flats extending from the stemmed washer.

Regarding claim 9, Bydalek discloses the standoff portion 36, the washer portion 32, and the retaining skirt portion 54 form a single-piece structure.

As to claim 12, Bydalek discloses the standoff portion 36 forms a hollow right cylinder.

In regards to claim 13, in Fig. 5 Bydalek discloses an internally threaded fastener assembly comprising an internally threaded fastener 18, a base 16 having a washer portion 32 with an abutment surface adapted to abut an outer surface of material, a standoff portion 36 adapted to extend from the washer portion such that the standoff

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portion extends substantially through a material of a defined thickness 40 and is capable of limiting displacement of a threaded fastener relative to the washer portion, and a retaining skirt portion 54 extending integrally from the washer portion and capturing the fastener rotatably in assembly with the base.

As to claim 14, Bydalek discloses the fastener includes a peripheral flange 22 extending radially therefrom, and the skirt portion captures the peripheral flange to retain the fastener in assembly with the base.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, and 4-6 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Hans (US3829163) in view of Bydalek (US 6435791).

Regarding claim 1, Hans discloses an internally threaded fastener assembly comprising a stemmed washer having a washer portion 6 with an abutment surface capable of abutting a surface of a material, a standoff portion 7 integral with the washer portion and configured to extend substantially through material of a defined thickness and substantially limit compressive loading on the material, and an internally threaded fastener 1 disposed adjacent to the washer portion. Hans fails to disclose a retaining

portion integral with the washer portion, and the internally threaded fastener retained rotatably in assembly with the stemmed washer by the retaining portion. Bydalek teaches a retaining portion 54 integral with a washer portion 32 that rotatably retains an internally threaded fastener 18. It would have been obvious at the time the invention was made to a person of ordinary skill in the art to include a retainer portion onto the stemmed washer of Hans as disclosed in Bydalek instead of using glue to more securely retain the fastener onto the washer, and so it can be easily mounted and removed.

Regarding claim 2, modified Hans discloses a peripheral flange 4 on the fastener, and the retaining portion extends radially inwardly to capture the flange and retain the fastener in the assembly.

As to claim 4, modified Hans discloses the standoff portion 7 forming a hollow right cylinder.

Referring to claim 5, modified Hans discloses the washer portion being generally planar.

Regarding claim 6, modified Hans discloses the fastener is a threaded nut 1 having flats extending from the stemmed washer.

5. Claims 1, 2, and 4-6 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Goiny (US 4969788).

Regarding claim 1, in Fig. 2 Goiny discloses an internally threaded fastener assembly comprising a stemmed washer having a washer portion 29 with an abutment surface capable of abutting a surface of a material, a standoff portion 14 integral with the washer portion and extending therefrom, and a retaining portion 28 integral with the

washer portion, and an internally threaded fastener 20 disposed adjacent to the washer portion and retained rotatably (see col. 4, l. 10-12) in assembly with the stemmed washer by the retaining portion. Although the standoff portion does not extend substantially through material of a defined thickness and substantially limit compressive loading on the material, it would be capable of extending substantially through a material depending upon how thick the material is in the particular application.

Regarding claim 2, Goiny discloses a peripheral flange 27 on the fastener, and the retaining portion extends radially inwardly to capture the flange and retain the fastener in the assembly.

As to claim 4, Goiny discloses the standoff portion 14 forms a hollow right cylinder.

Referring to claim 5, Goiny discloses the washer portion is generally planar.

Regarding claim 6, Goiny discloses the fastener is a threaded nut having flats extending from the stemmed washer.

6. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bydalek (US6435791) as applied to claims 1 and 7 above, and further in view of Goiny (US 4969788).

Bydalek discloses the claimed fastener assembly except for the washer portion being generally planar. Goiny teaches a generally planar washer portion 29 to fit the generally planar flange 27 of the nut. It would have been obvious at the time the invention was made to a person of ordinary skill in the art to include a generally planar washer and flange in Bydalek as disclosed in Goiny to facilitate manufacturing since a planar piece is easier to construct than a conical piece.

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7. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bydalek (US6435791) in view of Hans (US 3829163).

Regarding claims 26 and 27, in Fig. 5 Bydalek discloses a fastener kit comprising a stemmed washer having a washer portion 32, a standoff portion 36 integral with the washer portion, and a retaining portion 54 integral with the washer portion, an internally threaded fastener 18 disposed adjacent to the washer portion and retained rotatably within assembly with the stemmed washer by the retaining portion, wherein the standoff portion is capable of limiting relative displacement and compression of an externally threaded fastener and the washer portion of the stemmed washer to minimize compression of a material disposed therebetween. Bydalek also discloses a compressible substrate 40. Bydalek fails to disclose an externally threaded fastener which mates with the internally threaded fastener. Hans teaches an externally threaded fastener 10 which mates with the internally threaded fastener 1. It would have been obvious at the time the invention was made to a person of ordinary skill in the art to include an externally threaded fastener to mate with the internally threaded fastener of Bydalek as disclosed in Hans to fully install and tighten the assembly in place.

Response to Arguments

8. Applicant argues that both Bydalek and Goiny fail to disclose "a standoff portion...configured to extend substantially through the material". In response, the examiner disagrees because both Bydalek and Goiny disclose all the structural elements of the standoff portion, as well as disclosing both standoff portions extending substantially through each

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respective material. Bydalek clearly discloses the standoff 16 extending completely through the material 40 in Figure 5. Furthermore, Goiny discloses the standoff 14 capable of extending substantially through the material 6. Applicant is reminded that the claims are read in their broadest reasonable interpretation, and since only the fastener is being claimed the phrase "configured to extend substantially through the material" is a recitation of intended use.

Applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, Bydalek and Goiny are clearly capable of extending substantially through the material. The rejection is deemed proper and is therefore maintained. If applicant wishes to claim the features of the material into which the fastener is installed, the examiner suggests claiming the combination of the fastener and the material.

9. Applicant argues that both Bydalek and Goiny fail to disclose "a washer portion with an abutment surface adapted to abut a surface of a material". In response, the examiner disagrees because the phrase "adapted to abut a surface of a material" is considered to be a recitation of intended use. As stated above, applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case,

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both Bydalek and Goiny disclose an abutment surface capable of abutting a surface of material depending on the particular application of the invention.

10. Applicant argues that the combination of Hans and Bydalek is improper because the references "teach away from one another". In response, the examiner disagrees because the fastener in Hans is intended to be able to rotate. The fastener assembly disclosed in Bydalek is simply an improvement over the fastener assembly disclosed in Hans by replacing the use of a weak glue to connect the fasteners with a washer portion that still allows for relative rotation of the fasteners. The skilled artisan would have looked to Bydalek to improve the fastener of Hans to facilitate the installation of a fastener on a wheel. Therefore the rejection is deemed proper and is maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jori R. Schiffman whose telephone number is 703-305-4805. The examiner can normally be reached on M-Th, and every other Friday.

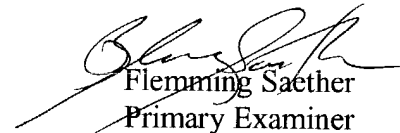
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on 703-308-1159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jori R. Schiffman
Examiner
Art Unit 3679

JS


Flemming Saether
Primary Examiner